

### *REMARKS*

#### *The Present Invention*

In some embodiments, the present invention relates to a pigmented cosmetic composition comprising a water-in-oil emulsion, in which the emulsion comprises (a) an oil phase; (b) an aqueous phase; (c) a pigment; (d) from about 3% to about 6% by weight of an emulsifier comprising a cetyl dimethicone copolyol; and (e) a separation inhibitor comprising a silicone elastomer, wherein the composition is stable for at least three months. In another embodiment, the present invention relates to a particulate sunscreen composition comprising a water-in-oil emulsion comprising (a) an oil phase; (b) an aqueous phase; (c) a particulate sunscreensing agent; (d) from about 3% to about 6% by weight of an emulsifier comprising a cetyl dimethicone copolyol; and (e) a separation inhibitor comprising a silicone elastomer, wherein the silicone elastomer comprises a dimethicone cross-polymer, wherein the composition is stable for at least three months.

#### *The Pending Claims*

Claims 1-4, 6-9, 11-32, and 52-58 are pending currently. Reconsideration of the pending claims is respectfully requested.

#### *The Amendments to the Claims*

The pending claims have been amended so as to more particularly point out and distinctly claim the subject matter of the present invention. In particular, claims 1, 28, 29, 52, and 58 have been amended to recite that the composition is stable for at least three months. This amendment is supported by the specification at, for example, page 6, lines 32-36. In addition, the element of claim 5 has been added to claims 1, 28, 29, and 58. As a result, claim 5 has been canceled as superfluous. No new matter has been added by way of any of these amendments.

#### *Summary of the Office Action*

The Office Action rejects claims 1-9, 11-32, and 52-58 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over Hollenberg (U.S. Patent No. 5,143,722) in view of Guthauser (U.S. Patent No. 5,162,378). Claims 1-4, 6-9, 11-32, 53, 54, 56, and 58 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated in view of Stepniewski et al. (U.S. Patent No. 5,599,533). In addition, claims 5, 55, and 57 are rejected under 35 U.S.C.

§ 103(a) as allegedly obvious over Stepniewski et al. (U.S. Patent No. 5,599,533) in view of Rapaport (U.S. Patent No. 5,730,991) and Dorogi et al. (U.S. Patent No. 5,882,661).

*Discussion of Rejections*

*(A) Hollenberg et al. and Guthauser*

Hollenberg et al. allegedly discloses a water-in-oil cosmetic composition containing an oil phase, water phase, a pigment, a sunscreensing agent, an emulsifier with an HLB value from 2 to 12 in 0.25-2 wt%, a thickener, an inorganic salt, a silicone elastomer, a glycol, and a preservative. The Examiner concedes that Hollenberg et al. does not disclose the use of a cetyl dimethicone copolyol in 3-6 wt% in the recited water-in-oil emulsion. Guthauser discloses a water-in-oil emulsion comprising 8-20 wt% cetyl dimethicone copolyol with an HLB value from 4 to 6, water, silicone elastomer, inorganic salts, and PEG. According to the Examiner, it would have been obvious to use a cetyl dimethicone copolyol in place of the emulsifier in the water-in-oil emulsions disclosed by Hollenberg et al. in order to arrive at the present invention. As for the limitation of claims 5 and 52 (i.e., about 3-6 wt% of an emulsifier comprising a cetyl dimethicone copolyol), the Examiner contends that one of ordinary skill in the art would arrive at this limitation through routine optimization.

The combination of Hollenberg et al. and Guthauser does not render the present inventive compositions obvious. Nothing in the disclosures of Hollenberg et al. or Guthauser would motivate one of ordinary skill in the art to select an emulsifier comprising a cetyl dimethicone copolyol in about 3-6 wt% and add it to the composition disclosed by Hollenberg et al. so as to arrive at the present inventive compositions as recited in claims 1-4, 6-9, 11-32, and 52-58. Even if, for the sake of argument, it were obvious to select a cetyl dimethicone copolyol as a surfactant (which applicant maintains is not the case), one of ordinary skill in the art would not add the cetyl dimethicone copolyol in an amount of about 3-6 wt%. After reading the specification of Guthauser, one of ordinary skill in the art would be led to add the surfactant in a relatively high amount, e.g., at least 8-20 wt%. Guthauser teaches away from adding the surfactant in a lower amount because "if the level of emulsifier is decreased to too low a level to minimize expense, a loss of stability and aesthetic appearance results, the composition becomes cloudy and opaque, and the viscosity of the composition in turn decreases resulting in an emulsion with less than desirable consistency." See Guthauser, col. 2, lines 1-6. Indeed, each of the examples taught by Guthauser describes the addition of a cetyl dimethicone copolyol to compositions in amounts such as 10 wt%, 11 wt%, 12 wt%, 15 wt%, 16 wt%, and 20wt% (see Abil B 9806/9808 of Example 1 and Abil B

9806 of Example 2). At best, the ordinarily skilled artisan might combine the disclosures of Guthauser and Hollenberg et al. and prepare a composition that included a surfactant comprising a cetyl dimethicone copolyol in an amount of 8-20 wt%.

Each of the pending claims requires an emulsifier comprising a cetyl dimethicone copolyol in an amount of about 3-6 wt%. According to the Examiner, this claimed amount can be derived from routine optimization. However, upon reading Guthauser, one of ordinary skill in the art would believe that the amount of 8-20 wt% cetyl dimethicone copolyol is already optimized. As discussed above, Guthauser expressly teaches away from using amounts of surfactant lower than 8 wt%. Hollenberg et al. teaches adding the surfactant in a very low amount, e.g., about 0.25-2 wt% (col. 6, lines 16-18). If Guthauser is considered an improvement over Hollenberg et al., again one of ordinary skill in the art would be led to add the surfactant in a higher amount (e.g., 8-20 wt%).

Applicant has discovered that adding about 3-6 wt% of an emulsifier comprising a cetyl dimethicone copolyol to the water-in-oil emulsion is critical to the present invention. As seen in the accompanying Rule 132 Declaration, a composition of the present invention was prepared with about 1 wt% cetyl dimethicone copolyol and about 8 wt% cetyl dimethicone copolyol as a surfactant (Comparative Samples A and B, respectively). The composition containing about 8 wt% cetyl dimethicone did not provide a stable emulsion at all. It separated into individual layers within a matter of days. Similarly, the composition containing about 1 wt% cetyl dimethicone copolyol provided an emulsion that was initially stable but fell apart after about one and a half months. According to the pending claims, a water-in-oil emulsion that includes an emulsifier comprising about 3-6 wt% of a cetyl dimethicone copolyol (such as the formulation set forth in Example 1) is stable for at least three months.

In view of these surprising and unexpected results, and without the motivation to include about 3-6 wt% of a cetyl dimethicone copolyol as an emulsifier to a water-in-oil emulsion based on the disclosures of Hollenberg et al. and Guthauser, claims 1-4, 6-9, 11-32, and 52-58 are unobvious. Accordingly, the obviousness rejection should be withdrawn.

(B) *Stepniewski et al.*

Stepniewski et al. reportedly discloses a water-in-oil cosmetic composition containing an oil phase, water phase, a pigment, vitamins A and E, a sunscreensing agent, a preservative,

cetyl dimethicone as an emulsifier, a thickener, a silicone elastomer, a glycol, and an inorganic salt. Claims 1-4, 6-9, 11-32, 53, 54, 56, and 58 are allegedly anticipated by the disclosure of Stepniewski et al. Claim 5 was not part of the anticipation rejection. The element of claim 5 has been added to independent claims 1, 28, 29 and 58. Since claims 2-4, 6-9, 11-27, 30-32, 53, 54, and 56 are either directly or indirectly dependent on claims 1 or 29, each of the rejected claims (i.e., claims 1-4, 6-9, 11-32, 53, 54, 56, and 58) now contain the element of claim 5. As such, none of these claims is subject to the anticipation rejection in view of Stepniewski et al., and applicant requests its withdrawal.

*(C) Stepniewski et al., Rapaport, and Dorogi et al.*

The Examiner concedes that Stepniewski et al. does not expressly disclose the use of a cetyl dimethicone copolyol in about 3-6 wt%. Rapaport discloses a skin peel composition that can include octyl methoxycinnamate as a sunscreen agent. Dorogi et al. discloses a composition for treating or conditioning human skin, hair, or nails. The composition can include phenoxyethanol, propyl paraben, and methyl paraben as preservatives. According to the Examiner, it would have been obvious to combine the elements disclosed by Rapaport and Dorogi et al. with the compositions taught by Stepniewski et al. in order to arrive at the invention of claims 55 and 57. As for claim 5, the Examiner contends that since Stepniewski et al. describes using a surfactant in 0.01-20 wt% (preferably 1-4 wt%) and also describes using a cetyl dimethicone copolyol, it would have been obvious to optimize this parameter and arrive at the limitation of pending claim 5.

Claims 55 and 57 are not obvious in view of the cited references because one of ordinary skill in the art would not be motivated to combine the disclosures of Rapaport and Dorogi et al. with that of Stepniewski et al. In particular, the compositions taught by Rapaport and Dorogi et al. are not a water-in-oil emulsion that comprises a pigment. In fact the compositions taught by Rapaport and Dorogi et al. are so different from that of Stepniewski et al. and the present invention that it is highly unlikely one of ordinary skill in the art would look to these references for any sort of guidance.

Regardless, as discussed above, the element of claim 5 has been added to each of pending claims 1-4, 6-9, 11-32, and 53-58. Rapaport and Dorogi et al. do not even mention the use of a cetyl dimethicone copolyol in any amount, let alone in the amount of about 3-6 wt%. Stepniewski et al. broadly describes the use of a surfactant in the range of about 0.01-20 wt%. Stepniewski et al. does not appreciate any benefit in providing a composition

In re Appln. of Brown  
Application No. 10/047,817

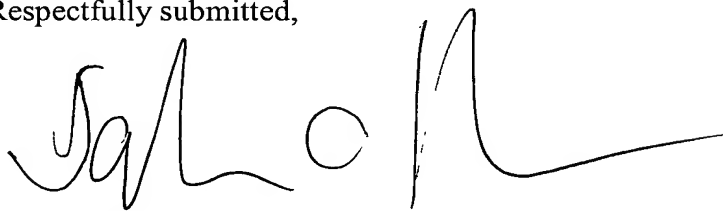
comprising about 3-6 wt% of a cetyl dimethicone copolyol. As described in detail in the accompanying Rule 132 Declaration, applicant found that there is surprising and unexpected stability in compositions prepared with about 3-6 wt% of an emulsifier comprising a cetyl dimethicone copolyol.

Since none of the cited references, including Stepniewski et al., discloses or fairly suggests the present invention as recited in the pending claims, nor the attendant unexpected stability, the present invention is patentable over the cited references. Accordingly, the obviousness rejection should be withdrawn and the application allowed.

*Conclusion*

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Salim A. Hasan', with a long horizontal flourish extending to the right.

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Date: September 2, 2004